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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,931	07/25/2003	David E. Slutz	M8540/279473	3653

23370 7590 03/24/2005

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EXAMINER
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TURNER, ARCHENE A

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/627,931

**Applicant(s)**

SLUTZ ET AL.

**Examiner**

Archene A Turner

**Art Unit**

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 16-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 45-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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1. Applicant's election with traverse of Group I in the reply filed on 2/7/05 is acknowledged. The traversal is on the ground(s) that the composite does not lose its identity when becoming the final products. This is not found persuasive because the final products are markedly different and the examiner maintains her position that the composite is an intermediate product and thus the restrictions stand.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 16-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/7/05.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-6, 8-11, 15, 45-46, 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohno (4,698,070).

Ohno discloses the claimed silicon carbide - silicon composite having a diamond coating thereon (abstract).

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5. Claims 1-15,45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Schachner et al (4,707,384)

Schachner et al discloses the claimed substrates having a diamond coating thereon (column 2, lines 34, 63-64).

6. Claims 1-2,4-15,45-46,48 are rejected under 35 U.S.C. 102(b) as being anticipated by Bou et al(5,705,262)

Bou et al discloses the claimed composite having a diamond coating thereon.

7. Claims 1,3-6,8-11,15,45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemelson et al (6,165,616)

Lemelson et al discloses the claimed composite having a diamond coating thereon (column 5, lines 42-45).

8. Claims 1-2,4-6,8-11,15,45-46,48 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikegaya et al (5,435,815).

Ikegaya et al discloses the claimed composite having a diamond coating thereon (column 8, lines 9-34).

9. Claims 1-2,4-15,45-46,48 are rejected under 35 U.S.C. 102(b) as being anticipated by De Beer Industrial (EP 540366).

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De Beers Industrial et al discloses the claimed Si-SiC composite having a diamond coating thereon (abstract).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Archene Turner whose new telephone number is (571) 272-1545. The examiner can normally be reached on Monday through Wednesday, and Friday from 10:30 am. to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Please remember to include on the fax, the art unit 1775, serial number and Examiner's name.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'A. A. Turner', with a long horizontal flourish extending to the right.

**A. A. Turner**  
**Primary Examiner**

Art Unit: \*\*\*

**Group 1700**

aat